

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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August 9, 2023

Opposition No. 91285597

Thirteen Lune, Inc.

v.

Relevant Cosmetics, LLC

Katie Bukrinsky, Interlocutory Attorney:

Unconsented Amendment

On July 29, 2023, Applicant filed an unconsented motion to amend its application as follows (deleted text in ~~strike through~~):

FROM: ~~Cosmetic balls; Cosmetic facial blotting papers; Cosmetic oils; Cosmetic oils for the epidermis; Cosmetic pads; Cosmetic pencils; Cosmetic powder; Cosmetic preparations; Cosmetic preparations for eyelashes; Cosmetic rouges; Cosmetics; Cosmetics and cosmetic preparations; Cosmetics and make up; Cosmetics for children; Cosmetics sold as an integral component of non-medicated skincare preparations; Cosmetics, namely, lip primer; Cosmetics, namely, lip repairers; Adhesives for cosmetic purposes; Adhesives for cosmetic use; Argan oil for cosmetic purposes; Beauty care cosmetics; Chalk for cosmetic use; Cleaner for cosmetic brushes; Cocoa butter for cosmetic purposes; Colour cosmetics for children; Compacts sold filled with cosmetic powder; Compacts sold filled with cosmetics; Cotton buds for cosmetic purposes; Cotton for cosmetic purposes; Eyebrow cosmetics; Gauze for cosmetic purposes; Gels for cosmetic purposes; Glitter for cosmetic purposes; Impregnated cleaning pads impregnated with cosmetics; Lip stains; Lip stains for cosmetic purposes; Milk for cosmetic purposes; Natural cosmetics; Non-medicated cosmetics; Nutritional oils for cosmetic purposes; Organic cosmetics; Paraffin wax for cosmetic purposes; Pencils for cosmetic~~

~~purposes; Pomades for cosmetic purposes; Pore tightening mask packs used as cosmetics; Pre-moistened cosmetic tissues; Pre-moistened cosmetic towelettes; Pre-moistened cosmetic wipes; Rose oil for cosmetic purposes; Shea butter for cosmetic purposes~~

TO: Cosmetic preparations; Cosmetics and cosmetic preparations

“An application subject to an opposition may not be amended in substance...except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board.” Trademark Rule 2.133(a). Generally, an unconsented motion to amend an application is deferred until final decision or until the case is decided upon summary judgment, unless (1) the proposed amendment limits the identification of goods or recitation of services, (2) the applicant consents to the entry of judgment as to the broader identification of goods or recitation of services, and (3) the applicant makes a *prima facie* showing that the amendment serves to change the nature and character of the goods and services or to restrict their channels of trade and customers in such a manner that a substantially different issue for trial has been introduced from the issue presented by the opposition against the application based on the original identification of goods or recitation of services. *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007) (proposed amendment not approved where applicant did not consent to entry of judgment as to the broader recitation of services); *see also* TBMP §§ 514.01 and 514.03 (2023).

Here, although Applicant’s proposed amendment is clearly limiting in nature, Applicant does not consent to the entry of judgment as to the broader recitation of goods and has not made a *prima facie* showing that the amendment serves to change

the nature and character of the goods or to restrict their channels of trade and customers in such a manner that the proposed amendment presents a substantially different issue for trial.

In view thereof, consideration of Applicant's proposed amendment is hereby **DEFERRED** until final decision or until the case is decided upon summary judgment. *See* TBMP § 514.01.¹

Suspension for Motion

On July 29, 2023, Applicant filed its answer to the notice of opposition. 4 TTABVUE. On July 31, 2023, Applicant filed a motion to dismiss the notice of opposition for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6). 6 TTABVUE.

Fed. R. Civ. P. 12(b) states that a motion asserting one of the defenses in that section, including failure to state a claim under Rule 12(b)(6), "must be made before pleading if a responsive pleading is allowed." Inasmuch as Applicant filed its motion to dismiss **after** filing its answer to the notice of opposition, the motion to dismiss is untimely. *See id.*; TBMP § 503.01.

Nonetheless, "the defense of failure to state a claim upon which relief may be granted may be raised at a later stage by other means, including a motion for judgment on the pleadings, which would be timely under the present circumstances." *Wellcome Found. Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.1 (TTAB 1998).

¹ The Board notes that the parties are engaged in settlement discussions. *See* 7 TTABVUE. If Opposer consents to Applicant's amendment, the parties may file a consented request to enter Applicant's proposed amendment. *See* TBMP § 514.02.

Accordingly, the Board construes Applicant's motion as seeking judgment on the pleadings. *See Western Worldwide Enters. Grp. Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990); TBMP § 503.01.

Proceedings are **suspended** pending determination of Applicant's construed motion for judgment on the pleadings. *See* Trademark Rule 2.127(d). Opposer's response to the motion, and Applicant's reply (if any), are due in accordance with Trademark Rule 2.127(a).

In view of the Board's suspension, the parties' consented motion to extend deadlines is **moot**.²

² If Opposer seeks an extension of time to respond to Applicant's motion, it must file a motion specifically requesting that relief. The filing of a form consent motion to extend discovery and trial deadlines does not have the effect of extending time to respond to a motion. *See* 7 TTABVUE.